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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,943	10/25/2001	Thomas W. Higgs	5087US (20618-US)	2308
24247	7590	11/21/2003	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			NINO, ADOLFO	
			ART UNIT	PAPER NUMBER
			2831	

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/056,943	Applicant(s) HIGGS, THOMAS W.	
	Examiner Adolfo Nino	Art Unit 2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 and 59-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-32, 41-44 and 59-63 is/are allowed.
- 6) ☒ Claim(s) 33 and 45 is/are rejected.
- 7) ☒ Claim(s) 34-40, 46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Objections

Claim 46 is objected to because of the following informalities:

Claim 46, line 3, "the boundary" should be ---the second opposing boundary---.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayward et al. (US 5,115,260).

Regarding claim 33 (Currently Amended), Hayward et al. disclose a strain control device (10 in fig. 2; col. 2, lines 17-18) comprising: a substantially rigid body (12 in fig. 1; col. 2, lines 19-20) extending longitudinally between a first end and a second end thereof (not marked, but clearly seen in figs.); and at least one cavity (24 in figs. 2, 4; col. 2, line 33) formed within a surface of the body between the first end and the second end, the at least one cavity (24) configured to receive at least a portion of a transmission line therein and wherein the at least one cavity defines a deviation path for the at least a portion of the transmission line (col. 1, lines 7-10) such that the at least a portion of the transmission line is enabled to be displaced between the first boundary of the cavity and the second opposing boundary of the cavity upon the elongation and

contraction of the body in a direction taken between the first and second ends (once the body elongate and contract due to outside forces or change in temperature, a portion of the transmission line is enabled to be displaced between the first boundary of the cavity and the second opposing boundary). **Note** that it has been held that the recitation that an element is “enabled to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re. Hutchinson, 69 USPQ 138. Moreover, language that does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Regarding claim 45 (Currently Amended), Hayward et al. disclose a strain control device (10) comprising; a substantially rigid body (12) extending between a first end and a second end thereof (not marked, but it would be one of the ends of body 12), the body having a first grasping member configured to frictionally engage a first portion of a transmission line (col. 2, lines 45-48) and a second grasping member (not marked, but it would be one of the ends of body 12) configured to frictionally engage a second portion of the transmission line (col. 2, lines 45-48); and at least one cavity (24) defined in the body between the first grasping member and the second grasping member, the at least one cavity (24) being configured to accommodate a third portion of the transmission line therein and defining a deviation path for the third portion of the transmission line (col. 1, lines 7-10) such that third portion of the transmission line may be displaced between a first boundary of the deviation path and a second opposing boundary of the deviation path upon elongation and contraction of the body in a direction taken between the first and second ends (once the body elongate and contract due to outside forces or change

Art Unit: 2831

in temperature, a portion of the transmission line is enabled to be displaced between the first boundary of the cavity and the second opposing boundary). **Note** that it has been held that the recitation that an element “enabled to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re. Hutchinson, 69 USPQ 138. Moreover, language that does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Allowable Subject Matter

Claims 1-32, 41-44 and 59-63 are allowed.

Claims 34-40 and 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner’s statement of reasons for allowance:

The primary reason for the indication of the allowability of claims 1-21 is the inclusion therein of the combination of “a substantially rigid body extending longitudinally between a first end and a second end thereof” and “a periphery of the at least one cavity being at least partially defined by a first wall and a second opposing wall which laterally deviates from the first wall” in combination with the other claim limitations. This combination was neither disclosed nor taught by the cited prior art, alone or in combination.

The primary reason for the indication of the allowability of claim 22-32 is the inclusion therein of the combination of "a substantially rigid body extending longitudinally between a first end and a second end" and "each of the at least a first plurality of cavities having a periphery which is at least partially defined by a first wall and a second opposing wall which deviates from the first wall" in combination with the other claim limitations. This combination was neither disclosed nor taught by the cited prior art, alone or in combination.

The primary reason for the indication of the allowability of claims 41-44 is the inclusion therein of the combination of "at least one substantially rigid body attached to a surface of the casing, the at least one body extending longitudinally between a first end and a second end" and "a periphery of the at least one cavity being at least partially defined by a first substantially linear wall and a second opposing wall which deviates from the first substantially linear wall" in combination with the other claim limitations. This combination was neither disclosed nor taught by the cited prior art, alone or in combination.

The primary reason for the indication of the allowability of claim 59 is the inclusion therein of the combination of "a substantially rigid body extending longitudinally between a first end and a second end thereof" and "the at least one cavity having a periphery defined at least partially by a first wall and a second opposing wall which deviates laterally from the first wall" in combination with the other claim limitations. This combination was neither disclosed nor taught by the cited prior art, alone or in combination.

The primary reason for the indication of the allowability of claims 60 and 61 is the inclusion therein of the combination of "a substantially rigid body extending longitudinally between a first end and a second end thereof" and "each cavity being at least partially defined by a first wall and a second wall which laterally deviates from the first wall" in combination with the other claim limitations. This combination was neither disclosed nor taught by the cited prior art, alone or in combination.

The primary reason for the indication of the allowability of claim 62 is the inclusion therein of the combination of "a substantially rigid body extending longitudinally between a first end and a second end thereof" and "wherein the at least one cavity is at least partially defined by a first substantially linear boundary and a second opposing boundary which deviates from the first substantially linear boundary" in combination with the other claim limitations. This combination was neither disclosed nor taught by the cited prior art, alone or in combination.

The primary reason for the indication of the allowability of claim 63 is the inclusion therein of the combination of "a substantially rigid body extending longitudinally between a first end and a second end thereof" and "wherein the at least one cavity is at least partially defined by a first substantially linear wall and a second opposing wall which deviates from the first substantially linear wall" in combination with the other claim limitations. This combination was neither disclosed nor taught by the cited prior art, alone or in combination.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

Art Unit: 2831

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

The following is a statement of reasons for the indication of allowable subject matter: With respect to claims 34-40, the cited prior art does not disclose nor teach, alone or in combination, the limitation therein of "wherein the first boundary is a substantially linear boundary and the second opposing boundary deviates from the first substantially linear boundary" in combination with the other claim limitations.

With respect to claim 46, the cited prior art does not disclose nor teach, alone or in combination, the limitation therein of "wherein the first boundary is a substantially linear wall and the second opposing boundary is a second opposing boundary wall which deviates from the first substantially linear wall" in combination with the other claim limitations.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adolfo Nino whose telephone number is (703) 305-1071. The examiner can normally be reached on M-F (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A Reichard can be reached on (703) 308-3682. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 2831

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

AN

 11/17/03
DEAN A. REICHARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800